

REMARKS

Claims 1 - 17 were pending in the application. Applicant kindly requests the Examiner to cancel claims 1, 2, 4, 7-9, 11, 12, and 14-17 without any prejudice or disclaimer to the subject matter expressed therein.

Further, Applicant kindly requests the Examiner to amend claims 3, 5, 6, 10, and 13 as shown in Attachment A. Applicants have amended claims 3, 5, 6, 10, and 13 to further particularly point out and distinctly claim the subject matter currently sought in this application.

The amendments do not constitute new matter within the meaning of 35 U.S.C. §132, thus entry of the amendments is kindly requested.

Rejections Under 35 U.S.C. § 101

The Examiner rejected claims 16 and 17 directed to non-statutory subject matter.

RESPONSE

Claims 16 and 17 have been cancelled, thus rendering the above rejection moot.

Rejections Under 35 U.S.C. § 112, 2nd Paragraph

The Examiner rejected claims 1-9, 16, and 17 as being indefinite.

RESPONSE

Claims 1, 2, 4, 7-9, 16, and 17 have been cancelled, thus rendering the above rejection on these claims moot. Claims 3, 5, and 6 have been amended to set forth and recite essential steps in the claims. As such, Applicant respectfully requests the Examiner to withdraw the rejection.

Rejection Under 35 U.S.C. 102(b)

The Examiner rejected claims 1 and 7-17 as being anticipated by U.S. Patent 5,809,145 to Slik, et al.

RESPONSE

Claims 1, 7-9, 11, 12, and 14-17 have been cancelled, thus rendering the above rejection moot in regards to such claims. Applicant traverses the rejections of claims 10 and 13.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must also be arranged as required by the

claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claims 10 and 13 have been amended to further particularly point out and distinctly claim the subject matter sought in this application, which also resulted in claims 10 and 13 patentably distinguishing themselves from Slik, et al.

The specific feature of the present invention resides in that considering indirect (secondary) usage of copyrighted digital data provided by a contents provider, only three data, i.e. (i) enciphered copyrighted digital data generated by enciphering the copyrighted digital data using encryption key data, (ii) digital sample preview data which is generated from an outline of the copyrighted digital data at a non-chargeable level without enciphering and is reproducible without the decryption key data, and (iii) additional data required for accounting are transmitted and copied from the first user terminal to the second user terminal among the enciphered copyrighted digital data, decryption key data for deciphering the enciphered copyrighted digital data, the digital sample preview data, and the additional data transmitted from the contents provider to the first user terminal that has completed a data usage accounting procedure.

In other words, according to the present invention, copyrighted digital data and additional data required for accounting can be delivered not only from a contents provider, but also from a user terminal that has completed an accounting procedure. Accordingly, an accounting procedure to be executed by a user who desires usage of the copyrighted digital data becomes simple and thus this makes it

possible to accelerate distribution of the copyrighted digital data while preventing the copyrighted digital data from being illegally copied.

Applicant respectfully contends that Slik et al. merely discloses a system in which digital data, accounting procedure data for using the digital data, and preview data for the digital data are delivered to a user via a CD-ROM or network, and the user can utilize the digital data only after obtaining an access code by using the accounting procedure data.

However, Slik et al. fails to teach, suggest, or disclose a system produced by considering indirect (secondary) usage of copyrighted digital data provided by a contents provider. Therefore Slik, et al. does not teach, suggest, or disclose a feature of the present invention, which is only the enciphered copyrighted digital data, the digital sample preview data, and the additional data are transmitted and copied from the first user terminal to the second user terminal.

Claims 10 and 13 are therefore asserted to be patentable over the Slik, et al. patent. Accordingly, Applicant kindly requests the Examiner for reconsideration and withdrawal of the rejections.

Rejection under 35 U.S.C. 103(a)

The Examiner rejected claims 2-6, and 9 as being obvious over Benson (U.S. Patent 6,301,660) in view of Slik (U.S. Patent 5,809,145).

RESPONSE

Claims 2, 4, and 9 have been cancelled, thus rendering the above rejection moot in regards to such claims. Applicant traverses the rejections of claims 3, 5, and 6.

The U.S. Supreme Court in *Graham v. John Deere Co.*, 148 U.S.P.Q. 459 (1966) held that non-obviousness was determined under § 103 by (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the art; and, (4) inquiring as to any objective evidence of non-obviousness.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970).

Further, the Examiner needs to show basis for combining the references to properly set forth a *prima facie* case of obviousness. The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper; In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The level of skill in the art cannot be relied upon to

provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). (Emphasis added) See MPEP 2143.01.

Claims 3, 5, and 6 have been amended to further particularly point out and distinctly claim the subject matter sought in this application, which also resulted in claims 3, 5 and 6 patentably distinguishing themselves from Benson and Slik, et al. separately and in combination.

Applicant incorporates herein the arguments set forth above for Slik, et al. As such, Applicant would like to reiterate that Slik, et al. does not disclose, teach, or claim a system produced by considering indirect (secondary) usage of copyrighted digital data provided by a contents provider. Therefore, Slik, et al. does not disclose the feature of the present invention, which is only the enciphered copyrighted digital data, the digital sample preview data, and the additional data are transmitted and copied from the first user terminal to the second user terminal.

The Benson reference does not remedy this deficiency. Benson merely disclosed a special viewer that is required for opening a file in a protected format. Benson, does not disclose, teach, or claim indirect (secondary) usage of copyrighted digital data as claimed in the present invention.

Claims 3, 5, and 6 are therefore asserted to be patentable over the Slik, et al. and Benson patents separately, and in combination.

Accordingly, Applicant kindly requests the Examiner for reconsideration and withdrawal of the rejections.

CONCLUSION

In light of the foregoing, Applicant submits that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Respectfully submitted,

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ATTACHMENT A

1. (Canceled)

2. (Canceled)

3. (Currently Amended) A copyrighted digital data management method for a network system in which first and second user terminals are connected to a contents provider via a network and are connected to each other via the network or a leased line wherein, the method comprising the steps of:

transmitting a request for using copyrighted digital data from said first user terminal to said contents provider;

~~after a first user terminal executes~~ executing a data usage accounting procedure ~~for~~ between said first user terminal and a contents ~~said contents provider, provider;~~

transmitting enciphered copyrighted digital data generated by enciphering ~~chargeable~~ the copyrighted digital data using encryption key data, decryption key data for deciphering the enciphered copyrighted digital data, digital sample preview data which is generated from an outline of the copyrighted digital data at a non-chargeable level without enciphering and is reproducible without the

~~decryption key data, decryption key data for deciphering the enciphered copyrighted digital data, and additional data required for accounting are transmitted from said contents provider to said first user terminal over a network and ;~~

~~recorded~~ receiving those data by said first user terminal and recording those data on a data recording medium ~~in said first user terminal, therein;~~ and

~~wherein, when the data recorded on said data recording medium in said first user terminal is copied to a data recording medium in a second user terminal over the network,~~ transmitting the enciphered copyrighted digital data, the digital sample preview data, and the additional data ~~are transmitted~~ without transmitting the decryption key data from said first user terminal to said second user terminal ~~over the network or a leased line.~~

4. (Canceled)

5. (Currently Amended) The copyrighted digital data management method according to claim 3 ~~wherein,~~ further comprising the steps of:

acquiring information on said contents provider based on the additional data received from said first user terminal by said second user terminal;

~~after said second user terminal executes~~ executing the data usage accounting procedure ~~for~~ between said second user terminal and said contents provider, ~~provider;~~ provider;

~~said contents provider transmits~~ transmitting from said contents provider to said second user terminal, the decryption key data for deciphering the enciphered copyrighted digital data received from said first user terminal ~~to said second user terminal over the network.~~

6. (Currently Amended) The copyrighted digital data management method according to claim 5 ~~wherein~~ further comprising the steps of:

~~said first user terminal is allowed to reproduce the digital sample preview data but, to reproduce the enciphered copyrighted digital data, is required to decipher~~ deciphering the enciphered copyrighted digital data received from said contents provider with the decryption key ~~data,~~ data received from said contents provider by said first user terminal and;

~~wherein said second user terminal is allowed to reproduce the digital sample preview data but, to~~

~~reproduce the enciphered copyrighted digital data, is required to obtain the decryption key data from said contents provider and then decipher~~ deciphering the enciphered copyrighted digital data received from said first user terminal with the decryption key data received from said contents provide by said second user terminal.

7. (Canceled)

8. (Canceled)

9. (Canceled)

10. (Currently Amended) A contents provider connected to first and second user terminals via a network, comprising:

receiving means for receiving a request for using copyrighted digital data and a data usage accounting procedure from [[a]] said first and second user terminal terminals; and

transmitting means for transmitting enciphered copyrighted digital data generated by enciphering ~~chargeable the~~ copyrighted digital data using encryption key data, decryption key data for deciphering the enciphered copyrighted digital data, digital sample preview

data which is generated from an outline of the copyrighted digital data at a non-chargeable level without enciphering and is reproducible without the decryption key data, ~~decryption key data for deciphering the enciphered copyrighted digital data,~~ and additional data required for accounting to said first user terminal ~~over a network, said data being all transmitted when~~ after said receiving means receives the data usage accounting procedure ~~is received~~ from said first user terminal, and transmitting the decryption key data to said second user terminal when said receiving means receives the data usage accounting procedure based on the additional data from said second user terminal.

11. (Canceled)

12. (Canceled)

13. (Currently Amended) A user terminal connected to a contents provider via a network and connected to another user terminal via the network or a leased line, comprising:

transmitting means for transmitting a request for using copyrighted digital data and a data usage accounting procedure to a procedure to said contents provider;

receiving means for receiving enciphered copyrighted digital data generated by enciphering ~~chargeable~~ the copyrighted digital data using encryption key data, decryption key data for deciphering the enciphered copyrighted digital data, digital sample preview data which is generated from an outline of the copyrighted digital data at a non-chargeable level without enciphering and is reproducible without the decryption key data, ~~decryption key data for deciphering the enciphered copyrighted digital data,~~ and additional data required for accounting, from said contents provider ~~over a network~~ after said transmitting means transmits the accounting procedure ~~is~~ executed for to said contents provider;

recording means for recording in a data recording ~~means~~ medium the enciphered copyrighted digital data, digital sample preview data, decryption key data, and additional data received by said receiving means;

reproducing means for reproducing the digital sample preview data recorded in said data recording ~~means~~ medium; and

deciphering means for deciphering the enciphered copyrighted digital data recorded in said data recording ~~means~~ medium,

wherein said transmitting means transmits the enciphered copyrighted digital data, the digital sample preview data, and the additional data recorded in said recording medium without transmitting the decryption key data recorded therein to the other user terminal.

14. (Canceled)

15. (Canceled)

16. (Canceled)

17. (Canceled)